

**REMARKS**

Reconsideration is respectfully requested.

Claims 1 through 43 remain in this application. No claims have been cancelled. No claims have been withdrawn. Claims 44 through 50 have been added.

The present Amendment attends to correction of some minor typographical errors (i.e., a missing period in claim 40) in the claims that are not thought to affect the patentability of the application.

Claims 1 through 43 have been rejected under 35 U.S.C. §102(e) as being anticipated by Miller, Jr. (U.S. 6,442,249) (hereinafter referred to as "Miller").

In general, the claimed invention includes a system having a privacy mode that may be invoked by a user for a communication device. When invoked, the privacy mode requires the entry of a privacy mode code by the caller of the incoming call for the call to be completed.

In particular, claim 1 requires "determining if the communication device is in a privacy mode" and "if the communication device is in the privacy mode, completing the call if a privacy mode code is entered by the caller". The privacy mode feature of claim 1 permits the user to require a caller to the communication device to enter a privacy mode code in order for the call to be completed.

The Miller patent discusses a system that checks the "carrier signal" of all incoming calls. The carrier signal is in fact the caller ID signal that includes any information on the origination of the call being received, and an "invalid carrier signal" is simply a call for which no originating telephone number is available in the caller ID information that accompanies

the call. Thus, correct operation of the Miller system requires that the user have caller ID service to his or her telephone line.

Generally, all incoming calls are handled in the same manner by the Miller system. If the caller ID signal associated with an incoming call is "valid", then the call is passed through to the phone regardless of the phone user's desire for privacy. And only if the caller ID signal associated with an incoming call is "invalid", then the caller hears a recorded message directing the person to enter an "override code" in order to have the call completed.

In greater detail, as can be appreciated from the initial portions of the flowchart of Figure 4 of the Miller patent, all incoming calls are examined for a "valid carrier signal", and the user is not able to alter this operation. As can also be appreciated from the flowchart of Miller's Figure 4, if the carrier signal is "valid" (i.e., the signal contains valid caller ID information--see, e.g., Miller at col. 3, lines 1 through 7), the Miller system continues and completes the call and the phone rings (see the boxes of the lower right side of the flowchart of Figure 4). The Miller system does not provide the user with any ability to prevent this completion of the call or stop the phone from ringing if the call has "valid" caller ID information associated with it.

Thus, whether or not an incoming call has "valid" or "invalid" caller ID information is dependent upon the caller and is completely out of the control of the user of the Miller system, and thus the user has no ability to cause the Miller system to enter any privacy mode and prevent all calls except for those that the caller knows a code, with all others blocked.

The Miller patent thus involves a system in which there is only one manner of operation, and that manner of operation handles incoming calls

based not upon any mode initiated on the Miller system by the user or any privacy wish of the user, but based solely upon the source (listed telephone line, unlisted telephone line, fax, computer) of the call. Again, this mode of operation cannot be altered by the user of the Miller system.

It is therefore submitted that the Miller patent could not lead one of ordinary skill in the art to the claim 1 requirement of "determining if the communication device is in a privacy mode", as the Miller system does not have any manner of operation or mode other than its unalterable manner of handling "valid" and "invalid" calls. Significantly, Miller does not discuss any mode of operation that provides privacy to the user of a communication device and only completes calls for which a privacy mode code is entered. The Miller system simply permits any call that has "valid" caller ID information associated with it to go through to the telephone regardless of whether the caller can enter a code.

In a real life application of the Miller system, the majority of the calls intercepted by the Miller system (i.e., those whose Caller ID signal represents a telephone number) are simply passed directly through to the user's telephone without any requirement that the caller enter anything that could be considered a privacy mode code. Only a limited number of calls would actually be required by the Miller system to enter an override code for the call to be passed through to the phone. Further, the "validity" of a call in the Miller system is not based upon any code entered by the caller (as required by claim 1), but simply upon the telephone number in the caller ID information of the caller.

It is contended in the Office Action that "valid carrier signal [of the Miller patent] = non-privacy mode [of the claimed invention]". However, the "validity" or "invalidity" of the carrier signal is determined by the character of the telephone line that the caller is calling from, and not any

“mode” of the telephone or the Miller apparatus, and thus the Miller system does not have a “privacy mode”. Clearly, the user of the Miller system has no ability to determine which incoming calls are “valid” or “invalid”, and thus the user cannot determine whether the calls will be passed to the telephone or whether the caller will be required to transmit an override code. One could never arrive at a privacy mode based upon the Miller teaching, as the user of the Miller system cannot control which calls are passed to the user’s telephone. In fact, in the Miller system, many calls, if not most calls, will be passed to the telephone without the caller even having to transmit an override code because these calls will include valid call ID information.

Further, the override code of the Miller system is incapable of functioning as a “privacy mode code”, as at the point that a caller is required to transmit the override code (see the flowchart in Figure 4 of Miller), calls with “valid” caller ID information have already been passed to the telephone, and thus whether or not the override code is transmitted by ~~the caller has absolutely no effect as to whether calls with “valid” caller ID~~ information are passed to the telephone.

It is therefore submitted that the prior art, and especially the Miller patent cited in the Office Action, would not lead one skilled in the art to the applicant’s invention as required by claim 1, especially with the requirements set forth above, and therefore it is submitted that claim 1 is allowable over the prior art. Further, claims 2 through 8, which depend from claim 1, also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Additionally, independent claim 20 includes the requirements “determining if the communication device is in a privacy mode” and “if the communication device is in the privacy mode, completing the call if a

predetermined code is entered by the caller" discussed above with respect to claim 1, and for the reasons set forth above with respect to claim 1, claim 20 is also submitted to be patentable over the Miller patent.

Claim 2 requires "if the communication device is in the privacy mode, routing the call to a message system if no privacy mode code is entered by the caller". In the system of the Miller patent, the only message discussed is a message that is played to the caller to prompt the caller to enter the override code if the caller ID information associated with the call is not "valid". Therefore, it is submitted that the Miller patent would not lead one of ordinary skill in the art to "routing the call to a message system if no privacy mode code is entered by the caller", as the Miller patent clearly involves the playing of a message that prompts the caller to enter an override code (see, e.g., col. 7, lines 27 through 28 and the flowchart of Figure 4) and thus the playing of the message in Miller comes before any override code is entered by the caller. It is therefore submitted that the Miller patent is incapable of leading one of ordinary skill in the art to the requirements of claim 2, or claims 11, 21, 24, 26, 33 and 38, which include requirements similar to claim 2.

Claim 3 requires that "the privacy mode code is selected by a user of the communication device". As noted above, the override code of Miller is incapable of anticipating the privacy mode code of applicant's claims, and therefore any ability of the user of the Miller system to change the override code does not anticipate the requirement of claim 3 that the privacy mode code is selected by a user. Therefore, claim 3 (as well as claims 14, 29, and 34 which include requirements similar to claim 3), is submitted to be patentable over the Miller patent.

Claim 6 requires "receiving a request from the communication device to place the communication device in the privacy mode". In addition to the

foregoing remarks in which it is shown that the Miller system does not include a privacy mode of operation, the Miller system also does not teach the ability to change the manner of operation of the Miller system with respect to calls having "valid" and "invalid" carrier signals. Further, the Miller patent does not disclose any ability to change operation of the system from the telephone, as clearly all of the controls for the Miller system are on the Miller unit. Therefore, claim 6 (as well as claims 17 and 40 which include requirements similar to claim 6), is submitted to be patentable over the Miller patent.

Claim 8 requires "receiving a request from the communication device to place the communication device out of the privacy mode". As noted above, the Miller system provides no means for the user to change the manner of handling the incoming "valid" and "invalid" calls, and therefore the user cannot request that the system be placed in any privacy mode or moved out of any privacy mode. As also noted above, Miller does not suggest any way of changing any operation of the system from a communication device, as all controls are clearly present on the Miller unit itself. Therefore, claim 8 (as well as claims 19 and 42 which include requirements similar to claim 6), is submitted to be patentable over the Miller patent.

Independent claim 9, in addition to requiring "determining if the communication device is in a privacy mode", also requires "if the communication device is in the privacy mode, providing a privacy mode message *including a selected privacy override code to the caller*" (emphasis added). (Claim 22 includes similar requirements.) This feature of the invention allows the caller to be put on notice that the user of the communication device desires privacy, but also provides the caller with the means to override the privacy mode so that, in the case of an emergency, the caller is able to get the call completed to the communication device without

prior knowledge of the privacy mode or override code.

Aside from the Miller system lacking any mode that provides the user with any meaningful privacy, it is submitted that that the Miller patent would never lead one of ordinary skill in the art to "provid[e] a privacy mode message including a selected privacy override code to the caller", as this would render the Miller system completely useless for its intended purpose of preventing unwanted telemarketers from being able to completing the call to the telephone. If the Miller system included a message that included an override code, any caller (including those with "invalid" caller ID information) would be able to get through the Miller system to the telephone. One would not modify the Miller system in a manner that would render the Miller ineffective for its primary intended purpose. Therefore, claim 9, as well as claims 10 through 19 which depend from claim 9, and claim 22, as well as claims 23 and 24 which depend from claim 22, are submitted to define over the Miller patent.

Independent claim 25 requires "a data entry device capable of receiving input to cause the communication device to enter a privacy mode" and "a receiver capable of completing the call to the user if a privacy mode code is entered by the caller". It has been shown above that the user cannot affect the manner in which the "valid" and "invalid" calls are handled, as all calls with "valid" caller ID information will automatically be passed through to the telephone, and all calls with "invalid" caller ID information will be screened. "Validity" is thus dependent upon the caller's telephone line, and is out of the control of the user of the Miller system, whether through a data entry device or any other means. Therefore claim 25, as well as claims 26 through 30 which depend from claim 25, are submitted to not be anticipated by the Miller patent and are in condition for allowance.

Independent claim 31, similar in some respects to claim 9, requires "a

data entry device capable of receiving input to cause the communication device to enter a privacy mode” and “a memory capable of providing a privacy mode message including a selected privacy override code to the caller prior to completing the call to the user”. As noted above with respect to claim 9, the Miller document would never lead one of ordinary skill in the art to “providing a privacy mode message including a selected privacy override code to the caller prior to completing the call to the user”, as this would render the Miller system futile in blocking telemarketer calls. Claim 31, as well as claims 32 through 34 which depend from claim 32, are therefore submitted to be allowable over the Miller patent.

Independent claim 35 requires “a data entry device capable of receiving input to cause the communication device to enter a privacy mode” and “a receiver capable of receiving the call to the communication device and completing the call to the user only if an interrupt is received from the caller”. The Miller system completes any call that includes “valid” caller ID information (i.e., a telephone number), and therefore it is submitted that ~~the Miller system does not “complet[e] the call only if an interrupt is~~ received from the caller”. The caller does not transmit anything to the Miller system to cause the Miller system to complete the call, since the call merely has to have “valid” caller ID information (provided by the telephone company) associated with the call for the Miller system to complete the call. Thus, it is submitted that the Miller patent does not anticipate the requirements of claim 35, and therefore claim 35, as well as claim 36 which depends from claim 35, are submitted to be in condition for allowance.

Independent claim 37 requires “a memory capable of storing a status indicating if the communication device is in a privacy mode” and “a transmitter capable of completing the call to the user if the communication device is in the privacy mode and the privacy mode code is entered by the caller”. In addition to the Miller system lacking any mode providing any



meaningful privacy, the Miller system lacks any manner for storing a status indicating that the Miller system is in such a privacy mode. As noted previously, the user of the Miller system is incapable of affecting how calls with "valid" and "invalid" caller ID information are handled, so storing a status of a mode of handling calls is not implied.

Based upon the foregoing, withdrawal of the §102(e) rejection of claims 1 through 43 is submitted to be appropriate, and allowance of claims 1 through 43 is therefore respectfully requested.

**Added Claims**

Added claim 44 requires that "if the communication device is in the privacy mode, passing the call to a voice messaging system if the privacy mode code is not entered by the caller" and "the voice messaging system being capable of recording a message spoken by the caller making the call". This feature of the claimed invention permits the caller to leave a message if the communication device is in the privacy mode and the user does not know the privacy mode code or does not wish to interrupt the privacy of the user of the communication device. The Miller system is only capable of reciting a message (to those callers without "valid" caller ID information) that instructs the caller to enter an override code, and the Miller patent does not disclose any means for recording a message from the caller. Therefore it is submitted that the Miller patent does not anticipate the requirements of claim 44.

Added claim 45 requires that "if the communication device is in the privacy mode, blocking completion of the call until the privacy mode code is entered", while added claim 46 requires that "if the communication device is in the privacy mode, preventing the communication device from producing an incoming call signal if the privacy mode code is not entered by the caller", added claim 47 requires that "if the communication device is in

the privacy mode, preventing the communication device from producing an incoming call signal for all calls for which the caller does not enter the privacy mode code", and added claim 48 requires that "if the communication device is in the privacy mode, requiring entry of the privacy mode code by the caller before the communication device produces an incoming call signal". As noted previously, the Miller system does not allow a user to put the system into a privacy mode that prevents the incoming call signal to be blocked or prevented until the caller enters a privacy mode code. Miller merely mentions that calls that do not have "valid" caller ID information must have an override code to be completed, but any call that includes "valid" caller ID information provided by the telephone company is automatically completed regardless of what the user of the Miller system does or doesn't do, or what the caller does or doesn't do. Thus, it is submitted that the Miller patent would not lead one of ordinary skill in the art to the requirements of claims 45 through 48.

Added claim 49 requires "establishing for the communications device a normal mode of operation and the privacy mode of operation" and claim 50 requires that "the normal mode of operation is characterized by producing an incoming call signal upon receipt of the call, and the privacy mode is characterized by producing the incoming call signal only if the caller has entered the privacy mode code". As is described in the applicant's specification at length, when invoked by the user, the privacy mode of the communication device causes the system to screen incoming calls, and only those calls for which the caller enters the privacy mode code are allowed to cause the incoming call signal to be produced. The normal mode of operation does not screen the calls in this manner, and the communication device operates in the normal manner. As can be appreciated from the above remarks, the user of the Miller system has no ability to change the way incoming "valid" and "invalid" calls are handled.

Appln. No. 09/752,037

Amendment dated October 8, 2003

Reply to Office Action mailed July 8, 2003

Calls with "valid" caller ID information are automatically passed through to the phone and the user is interrupted, while only calls with "invalid" caller ID information are required to have additional steps performed to be completed.

Allowance of added claims 44 through 50 is therefore respectfully requested.

### CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

KAARDAL & LEONARD, L.L.P.

By 

Date: October 8, 2003

Ivar M. Kaardal (Reg. No. 29,812)

KAARDAL & LEONARD, L.L.P.

3500 South First Avenue Circle, Suite 250

Sioux Falls, SD 57105-5802

(605)336-9446 FAX (605)336-1931

e-mail patent@kaardal.com